

REMARKS

This amendment is in response to a non-final Office action (Paper No. 35) mailed August 17, 2004. Upon entry of this amendment, claims 1-3, 17 and 24-49 will be pending in this application. Applicant has amended claim 2 and 17 by this amendment and newly added claims 44 through 49 by this amendment.

In Paper No. 35, the Examiner rejected claims 1-3 and 24 - 43 under 35 U.S.C. 103 (a) using USP 5581685 to Sakurai in view of newly cited USP 5929932 to Otsuki. Applicant traverses this rejection for the following reasons.

I. Use of Sakurai '685 inappropriate in Paper No. 35

In the rejection of these method claims in Paper No. 35, the Examiner places emphasis on the "area indicator" illustrated in FIG 13A of Sakurai '685 and on reference numeral 11 of FIG. 5 of Sakurai '685. The Examiner justifies these rejections by stating, "it would have been obvious to one skilled in the [art] at the time of the invention was made to modify *Sakurai's menu display system* to adapt Otsuki's displaying of a sub-menu and the corresponding automatic movement of a cursor into a sub-menu as illustrated Fig. 3 (5,6)." Applicant disagrees.

Sakurai '685 is about definition files, not about displays and not about cursor repositioning

To begin with, Sakurai '685 is not about a menu display system as asserted by the Examiner

in Paper No. 35 but is instead about structuring of definition files stored in memory. Sakurai '685 focuses on how these menus or definition files are stored in memory and executed from memory and little on display of menus and none on cursor display and cursor positioning. This can be gleaned from reading Sakurai '685 in its entirety and from column 3, lines 40-50 of Sakurai '685, which describes that Sakurai '685 seeks to provide a menu system that can construct a hierarchical structure with no restriction on the numbers of menu items and hierarchy levels along with a method that allows easy setup of processes (pre-command) before the execution of a selected item and before return to previous menu. And secondly, Applicant submits that one of ordinary skill in the art would not be motivated to turn to Otsuki '932 to fill in for the deficiencies of Sakurai '685 because Otsuki '932 pertains to a display controller while Sakurai '685 pertains to a structure for definition files. In other words, Applicant submits that the Examiner mischaracterized the Sakurai '685 patent to 1) justify the combination with Otsuki '932 and 2) to form a link between Sakurai '685 and Applicant's invention where none exists.

In FIG. 13A of Sakurai '685, Applicant submits that the area indicator displayed is not a cursor on a display. Instead, area indicator is a memory address (or a pointer) that shows where in memory data is being consulted from. A pointer in computers is when the contents of memory contain an address as opposed to data. This is different from a cursor or a pointer on a display monitor. In FIG. 13A, the area indicator is pointing to the fourth level menu. FIG. 13A is never displayed on a monitor, it is used to show how a computer keeps track of what is currently being executed by a computer. Thus, Sakurai '685 pertains to hardware and software concepts, not to

display or video imaging and not to control of a location of a cursor or an indicator on a display monitor.

Similarly, FIG. 5 of Sakurai '685 is not about cursor control or positioning of a cursor. Instead, FIG. 5 pertains to a correspondence between what is displayed and what is stored in the definition file stored in memory. Reference numeral 11 is not a cursor and is not about a position of a cursor but is used to depict submenu 1 being selected. Reference numeral 11 is not intended to be displayed. Neither FIG. 5 nor FIG. 13 nor any part of Sakurai '685 is about display, a cursor, a positioning of a cursor or use of a cursor. Instead, Sakurai '685 pertains to a method of making a definition file for a menu, the definition file being stored in memory. For this reason, Applicant submits that it was inappropriate for the Examiner to either combine Otsuki '932 with Sakurai '685 or to apply Sakurai '685 against Applicant's claims. Because Sakurai '685 is unrelated to Otsuki '932 and Applicant's invention, and because the Examiner relied on Sakurai '685 in Paper No. 35 to reject claims 1-3 and 24 - 43, Applicant submits that the rejection to claims 1-3 and 24 - 43 must be withdrawn.

II. Reversion to previous menu and the associated automatic cursor repositioning feature

Regarding claims 24, 29, 35, 36 and 43, Applicant claims that during reversion from a submenu back to a main or previous menu, the cursor automatically skips back to the previously selected item in the main menu when the main menu is displayed. Applicant submits that 1) this feature was never examined by the Examiner in Paper No. 35 and 2) that the applied prior art fails

to teach or suggest this feature.

In Paper No. 35, the Examiner **rejects claim 24** by referring to the flow chart of FIG. 18 of Otsuki '932. Applicant disagrees. Applicant submits that the flag setting and resetting the Examiner is referring to in the rejection of claim 24 in Paper No. 35 is about a split screen as in FIGS. 13 and 14 of Otsuki '932. In the split screen, one half is active and the other half is not active. The active screen appears opaque and the inactive side is displayed in halftones. This opaque and halftone display is used to make it intuitive to the user which side of the split screen is active and which side is not active. Applicant submits that this has nothing to do with display of a cursor, cursor positioning or reversion from a sub menu to its parent or previous or main menu as claimed by Applicant in claim 24.

In the rejection of claims 29, 35, 36, and 43 in Paper No. 35, the Examiner relies on column 16, lines 16-19 of Otsuki '932. Applicant disagrees. This section of Otsuki '932 pertains to the user pressing a cancel button causing the display to go from a list display of FIG. 22 to a first letter selection display screen of FIG. 23. Applicant has the following comments. First of all, this passage and this entire portion of Otsuki '932 does not specify and does not pertain to cursor positioning, cursor skip or automatic repositioning of the cursor. When the display reverts from the list display to the first letter selection display screen in Otsuki '932, there is no discussion of where the cursor appears on the first letter selection display screen. Because Otsuki '932 is silent regarding the repositioning of the cursor when the first letter selection display screen appears, Applicant submits

that the feature of automatically repositioning on the previously selected menu option feature of these claims is not taught by the applied prior art.

In the rejection of claims 29, 35, 36, and 43 in Paper No. 35, the Examiner also relies on step 7 of FIG. 3 of Otsuki '932. Applicant disagrees. Applicant submits that step 7 in FIG. 3 does not pertain to reversion from a submenu to its parent or main menu. Furthermore, FIG. 3 and its discussion thereof does not pertain to automatic repositioning of a cursor to the previously selected item in the main menu. Step 7 of FIG. 3 pertains to the fact that the process does not continue until an item on the sub menu is selected, not the reversion and the associated automatic cursor repositioning Applicant is claiming.

III. Cursor is automatically moved to first item in submenu feature

In claims 2, 31 and 34, Applicant claims that when a submenu appears, that the cursor is automatically repositioned in the *first item* of the submenu. Applicant submits that this feature was never addressed in Paper No. 35. Applicant also submits that by moving the cursor by operating buttons 5a through 5d in Otsuki '932 is not automatic repositioning of the cursor. Therefore, Applicant submits that the rejection to claims 2, 31 and 34 must be withdrawn.

IV. Cursor automatically moved to geometric center of item feature

In claims 33 and 34, Applicant claims that the cursor is automatically initially repositioned to the *geometric center* of the first item in a menu. In Paper No. 35, the Examiner states that col 3,

lines 31-37 and col 6, lines 33-35 of Otsuki '932 teaches this feature. Applicant disagrees. Applicant submits that col 3, lines 31-37 of Otsuki '932 pertains to the split screen of FIGS. 13 and 14. There is no discussion of automatic cursor repositioning to a center of an item in Otsuki '932. Applicant also submits that col 6, lines 33-35 of Otsuki '932 pertains to user manipulation of cursor movement keys 5a through 5d to move the cursor, not to automatic repositioning of the cursor as claimed by Applicant in claims 33 and 34. Therefore, the rejection of claims 33 and 34 must be withdrawn.

V. Automatic cursor movement during Enlargement/ Reduction of a menu

Regarding claims 30 and 37, Applicant claims the enlargement and reduction of a menu and the automatic cursor repositioning that goes along with it. In Paper No. 35, the Examiner states, "Regarding claims 30 and 37, Otsuki teaches an operating section (105) which is provided with a menu key (111) as illustrated in Fig. 13. Ot[t]suki as mentioned above also teaches that when the sub-menu is displayed, the cursor is automatically moved onto the sub-menu." Applicant disagrees. Applicant submits that FIG. 13 of Otsuki '932 and reference numerals 105 and 111 of Otsuki '932 has nothing to do with menu enlargement or menu reduction. Furthermore, FIG. 13 of Otsuki '932 and reference numerals 105 and 111 of Otsuki '932 has nothing to do with automatic cursor repositioning during menu enlargement or menu reduction.

Applicant further submits that menu enlargement or menu reduction displays the *same* menu, not a sub menu or some different hierarchical menu. Therefore, Applicant submits that it was

inappropriate for the Examiner to focus on sub-menu when the claim does not pertain to going from a menu to a submenu, but to enlargement or reduction of the same menu with the same options, only bigger or smaller. Because there is no teaching of Applicant's menu enlargement and menu reduction feature along with the automatic repositioning of the cursor that goes along with it, the rejection to claims 30 and 37 must be withdrawn.

VI. "Focus" of Otsuki '932 is not comparable to Applicant's indicator

The concept of a cursor in Otsuki '932 is much different than the indicator in Applicant's claimed invention. In Applicant's claimed invention, the indicator can be moved freely on the display screen regardless of the existence and location of a menu. Meanwhile, in Otsuki '932, the cursor can only be moved within the boundary of the menu. In Otsuki '932, to show that an item is selectable by the indicator, the item's color is converted. This is referred to as "focusing". Thus, the cursor of Otsuki '932 does not correspond to Applicant's indicator, but instead to the focus.

Furthermore, Applicant's invention pertains to an indicator *in combination with* automatic repositioning feature when a menu appears. In Paper No. 35, the Examiner justifies rejecting this combination of features by turning to the hierarchical teachings of Sakurai '685 with Otsuki '932. Applicant disagrees.

The use of the focusing of Otsuki '932 with the hierarchy menu system of Sakurai '685 can produce a result in which one of the items in a menu is color-converted or focused when a menu is

newly created. However, the location of the indicator in the combination of references is maintained as before, and a user must move the indicator to a desired position in the newly created menu. Thus, the proposed combination of Sakurai '685 and Otsuki '932 in Paper No. 35 cannot produce a result in which the indicator is located within the boundary of the newly created menu, as can be done in Applicant's invention. Thus, even if combined, the combination of Sakurai '685 and Otsuki '932 does not result in Applicant's claimed invention.

VII. Apparatus claim 17

In Paper No. 35, the Examiner rejected claim 17 under 35 U.S.C. 103 (a) as being unpatentable over USP 5648781 to Choi in view of Otsuki '932. In claim 17, Applicant claims, "the indicator display unit causing the location of the indicator on the television display screen to move on the display screen when the trackball moves, the indicator display unit also causing the indicator to suddenly and automatically jump to a new location on the television display screen when said television display screen displays a different menu." Thus, Applicant is claiming that the indicator display unit responds to both (1) manual trackball movement and (2) selection of a menu item to automatically move the cursor on the display. Applicant submits that this combination of the manual trackball and the automatic sudden jumping of the position of the cursor is not contemplated by the combination of Choi '781 and Otsuki '932. Otsuki '932 uses buttons to manually control the position of the cursor on the display. In Otsuki '932, when a user pushes these buttons, the cursor skips. In Applicant's invention, the trackball causes the cursor to slide, not skip. It is during menu selection and the appearance of the submenu where the cursor skips in Applicant's invention.

Applicant submits that if Choi '781 were modified according to Otsuki '932, the trackball of Choi '781 would be replaced by the buttons as in Otsuki '932 to manually move the cursor. The conclusion that combining Otsuki '932 with Choi '781 leads to a remote control with a trackball instead of buttons to move the cursor manually can only be arrived by improper hindsight reconstruction using Applicant's claim as a blueprint and picking and choosing features from these two references to defeat Applicant's claims. There is no justification for combining the trackball with automatic cursor skip to arrive at Applicant's invention. Therefore, the rejection to Applicant's claim 17 must be withdrawn.

Regarding claim 43, Applicant notes that this claim was never examined in Paper No. 35. As a result, Applicant submits that Paper No. 35 is an incomplete Office action in violation of 37 C.F.R. 1.104 (b).

VIII. Amendments and Newly added claims

Applicant is amending claims 2 and 17 by this amendment to correct for minor errata.

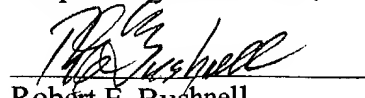
Applicant is newly adding claims 44 through 49 by this amendment. Claims 44 and 45 are essentially unexamined claim 41 but depend from other independent claims. Each of these claims claim that the main menu disappears from the display when a sub menu appears. Applicant submits that Otsuki '932 shows that the main menu is displayed along with the submenu. Regarding claims 46 and 47, these claims depend from apparatus claim 17 and claim that the indicator display unit that

controls the position of the indicator in the display receives signals from two sources, (1) the trackball and (2) menu selection from buttons pushed to cause the indicator to skip to the new location. Claims 48 and 49 claim the trackball causing the cursor to slide and not skip across the display screen. Applicant submits that the applied prior art fails to fairly teach the combination of the trackball and the automatic skip feature. Entry of and favorable examination of these claims is respectfully requested.

A fee of \$108 is incurred by the addition of six (6) more claims in excess of 24. Applicant's check drawn to the order of Commissioner accompanies this Response. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the Examiner is asked to contact the Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040
Folio: P55862
Date: 11/17/04
I.D.: REB/ML